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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,291	11/19/2001	Michael J. Rothman	47004.000180	8456
21967	7590	04/26/2005	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			HAQ, NAEEM U	
		ART UNIT	PAPER NUMBER	
		3625		
DATE MAILED: 04/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/988,291	ROTHMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
**THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 59-61,63-75,77-87,89-97 and 99-131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 59-61,63-75,77-87,89-97,99-106,110,111,117-122,130 and 131 is/are rejected.
- 7) Claim(s) 107-109,112-116 and 123-129 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Applicants' claim to priority to US Patent 6,505,168 B1 is hereby acknowledged. However, limitations in the current application which lack proper written description support in the US Patent are as follows:

Claims 59-61, 63-75, 77-87, 89-97, and 99-131 recite the limitation "merchant level". This limitation is not disclosed in US Patent 6,505,168 B1. This limitation was first presented in an amendment filed on February 10, 2003.

### ***Specification***

The disclosure is objected to because of the following informalities: Page 6, line 12 of the specification discloses that at step 106 customer information is placed in the appropriate locations of the organizational structure. However, Figure 5 shows that this occurs at step 108. Page 8, line 9 of the specification recites "A organizational..." This should be changed to "An organizational..." Page 12, line 7 of the specification references "Fig. BB". The Examiner is unable to locate this figure in the drawings submitted with this application. Appropriate correction is required.

### ***Claim Objections***

Claims 102-106 are objected to because of the following informalities: These claims recite “The method of claim 97...” However, the Examiner notes that claim 97 is system claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 59-61, 63-75, 77-87, 89-97, 118, and 99-131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 59-61, 63-75, 77-87, 89-97, and 99-131 recite the limitation “merchant level”. This limitation lacks proper written description support in the specification.

Claims 118 and 131 recites the negative limitation “...and not to any particular item purchased at a particular merchant.” This limitation lacks proper written description support in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 59-61, 63-75, 77-87, 89-97, and 99-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation "merchant level". The Applicants' specification does not provide a definition for this limitation. Furthermore, the specification does not distinguish this limitation from the limitation "customer purchase information". For examination purposes, the Examiner will assume that "merchant level customer purchase information" is same as "customer purchase information" and that "merchant level offer" is the same as "offer". Moreover, these claims fail to point out the invention which the Applicants' have described in their specification. The Applicants' specification discloses that the customer preference is created based on the information stored in the organizational structure (see specification page 2, lines 12-15; page 3, lines 3-6; page 5, lines 10-21; page 6, line 12 – page 7, line 3). The Examiner notes that this feature is not claimed in any of the claims. For example, claim 59 recites the steps of receiving customer purchase information, organizing the customer purchase information, creating a customer preference, and forming an offer based on the customer information. The step of creating does not explicitly state that the preference is created based on the information stored in the organizational structure, as disclosed in the specification. The Examiner recommends that the Applicants amend the claim language to state that the

customer preference is created based on the customer information contained in the categories and sub-categories of the organizational structure.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 59-61, 63-75, 77-87, 89-97, and 99-131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 6,505,168 B1 to Rothman et al. in view of US Patent No. 6,026,370 to Jermyn.**

Rothman teaches the steps of receiving and organizing the customer purchase information. The Applicants have argued that Rothman does not teach the features of "creating a customer preference based at least in part on the merchant level customer purchase information". The Examiner respectfully disagrees. Rothman teaches "creating a customer preference based on the customer purchase information..." (claim 5). As noted above in the 112 rejection, the Applicants' specification does not define

“merchant level customer purchase information” nor does it differentiate between “merchant level customer purchase information” and “customer purchase information”. This lack of distinction renders the limitations essentially the same to one of ordinary skill in the art because both limitations are directed to a customer’s purchase information. Furthermore, the Examiner notes that the limitation “merchant level” is not functionally or structurally involved in the steps or elements of the recited method and system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements of the method and system would be the same regardless of what adjectives were used to describe the term “customer purchase information”. The differences between the Applicants’ purchase information and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any adjective to describe the purchase information of the prior art because such information does not functionally or structurally relate to the steps or elements of the claimed method and system and because the subjective interpretation of information does not patentably distinguish the claimed invention. Rothman does not claim the feature “forming a merchant level offer for a customer based on at least one of the customer preference and the merchant level customer purchase information”. However, Jermyn teaches generating an offer based on customer purchase history (Abstract). Therefore

it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Jermyn into the invention Rothman. One of ordinary skill in the art would have been motivated to do so in order to avoid the wasteful practice of mass mailing of offers by identifying and targeting an offer to a particular consumer most likely to accept the offer, as taught by Jermyn (column 1, lines 5-64). The cited prior art does not teach the limitation "merchant level". However, the Examiner notes that this limitation is not functionally or structurally involved in the steps or elements of the recited method and system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements of the method and system would be the same regardless of what adjectives were used to describe the term "offer". The differences between the Applicants' "offer" and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any adjective to describe the "offer" of the prior art because such information does not functionally or structurally relate to the steps or elements of the claimed method and system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 59-61, 63-72, 87, 89, 90-96, 107-108, 110, and 112-131 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "whoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

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subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The

court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001). Although Bowman is not precedential, it has been cited for its analysis.

In the present application, claims 59-61, 63-72, 87, 89, 90-96, 107-108, 110, and 112-131 are not within the technological arts because the claims do not utilize technology in a non-trivial manner in order to perform the steps of receiving, organizing, creating, and forming.

In order to overcome this rejection, the Examiner recommends that the Applicants amend the claim language to incorporate non-trivial use of technology in the body of the independent claims.

**Claims 59-61, 63-72, 107, 108, 110, and 112-131 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

35 U.S.C. 101 requires that in order for an invention to be patentable it must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicants' claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The independent claims 59 and 130 begin by discussing a system for storing and manipulating information but then include the specific steps of a method. "*A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only*", Ex parte Lyell (17 USPQ2d 1548). In order to overcome this rejection, the

Examiner recommends that the Applicants limit the independent claims to one statutory class of invention.

***Allowable Subject Matter***

Claims 107-109, 112, 116, 123, 128, 129 are objected to as being dependent upon a rejected base claim, but would be allowable if amended to overcome the rejections under 35 U.S.C 112 and 101 and rewritten in independent form including all of the limitations of the base claim **and all intervening claims**.

The prior art does not teach or render obvious the following:

Referring to claims 107-109, the cited prior art multiple scores are based on purchases by a customer from different merchants.

Referring to claim 112, 116, 128, and 129, the cited prior art does not teach that the categories and sub-categories are associated with a percentage/count value indicating customer activity with a particular category or sub-category.

Referring to claim 123, the cited prior art does not teach that the score is based number of purchases or total dollar amount of purchases made by the a consumer in a particular category or sub-category.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 59, 61, 63-66, 71-73, 75, 77-80, 85-87, 95-97, 105, 106, 110, 111, 117, 119-121 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) hereinafter referred to as Chakrabarti.**

Referring to claims 59, 73, 87, 97, and 130, Eldering teaches a method and system comprising: receiving merchant-level customer purchase information (column 1, lines 25-50; column 6, lines 33-43; column 7, lines 55-67); organizing the merchant level customer purchase information within a predetermined organizational structure, wherein the predetermined organizational structure comprises a plurality categories arranged in a hierarchy (column 7, lines 22-34; column 8, lines 20-30); creating a customer preference based at least in part on the merchant level customer purchase information (Abstract; column 1, lines 51-58); forming a merchant level offer for a customer based on the merchant level customer purchase information (column 1, lines 51-58; column 3, lines 13-28; column 4, lines 21-25). Eldering does not teach that each category comprises a plurality of sub-categories or that the hierarchy has a top-down taxonomy. However, Chakrabarti teaches a method and system for cataloging user information in a hierarchical database structure comprising a plurality of sub-categories and having a top-down taxonomy (column 1, lines 8-42; Figures 2-4). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate the teachings of Chakrabarti into the invention of Eldering. One of ordinary skill in the art would have been motivated to do so in order to logically organize and further refine the classification of Eldering by using the sub-categories and top-down taxonomy of Chakrabarti.

Referring to claims 61 and 75, Eldering teaches extending the offer via direct mail (Figure 1A, item "182").

Referring to claims 63 and 77, these limitations are inherent in the cited prior art because the cited prior art teaches that a computer system maintains the organizational structure.

Referring to claims 64 and 78, Eldering teaches forming an offer for goods and services (column 3, lines 22-28; column 7, lines 55-67).

Referring to claims 65, 66, 71, 72, 79, 80, 85, 86, 95, 96, 105, 106, 110, 111, 117, 119-121, the cited prior art does not teach that the purchase information comprises an amount of purchase, location of purchase, merchant name, or a merchant category code. However, the Examiner notes that this limitation is not functionally or structurally involved in the steps or elements of the recited method and system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements of the Applicants' invention would be the same regardless of what information the purchase information contained. The differences between the content of the Applicants' purchase information and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the purchase information of the cited prior art because such information does not functionally or structurally relate to the steps of elements of the claimed method system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

**Claims 67, 81, 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) hereinafter referred to as Chakrabarti and further in view of Ellis et al. (US PUB 2003/0020744 A1) hereinafter referred to as Ellis.**

Referring to claims 67, 81, and 122, the cited prior art does not teach generating a customer score based on customer accounts prior to creating a customer preference. However, Ellis teaches a method and system for targeted advertisement (Abstract) wherein a user's history is used to generate a value (i.e. score) prior to creating a preference (paragraphs [0107] and [0126]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Ellis into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to create an advertisement/offer that was highly appealing to a particular user.

**Claims 60, 68, 69, 74, 82, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) hereinafter referred to as Chakrabarti in view of Official Notice.**

Referring to claims 60 and 74, Eldering teaches that a consumer can receive information from a PC (column 5, lines 9-15; column 14, lines 8-21). Eldering does not explicitly teach that the offer is extended via e-mail or web page. However, Official Notice is taken that it is old and well known in the art to extend an offer via e-mail. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate e-mail functionality into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to use a well-known communication medium to reach a large group of people for targeted advertisement.

Referring to claims 68, 69, 82, and 83, Eldering does not teach updating the organizational structure when the information reaches a threshold level. However, Official Notice is taken that it is old and well known in the art to update a database after a predetermined time or level. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to keep the hierarchy of the cited prior art current.

**Claims 70, 84, 89-94, and 99-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) hereinafter referred to as Chakrabarti and further in view of Guheen et al. (US PUB 2004/0107125 A1) hereinafter referred to as Guheen.**

The cited prior art does not teach matching selected words or characters with words or characters contained within the customer purchase information. However, Guheen teaches this limitation (paragraph [3117]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Guheen into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to create an advertisement/offer that was highly appealing to a particular user.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

April 14, 2005

  

Y. C. Gao  
Primary Ex